

#10  
Suppl. Amended  
+ attach  
11/20/01

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Better *et al.*

Appl. No. 09/610,838

Filed: July 6, 2000

For: **Fusion Proteins And  
Polynucleotides Encoding Gelonin  
Sequences**

Art Unit: 1643

Examiner: A. Salimi

Atty. Docket: 0610.099000A/MAC

**Supplemental Amendment  
and Reply Under 37 C.F.R. § 1.111**Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Supplemental to Applicants' timely filed reply to the Office Action of March 14, 2001, Applicants submit the following amendments and remarks. This Amendment is provided in the following format:

- (A) A clean version of each replacement paragraph/section/claim along with clear instructions for entry;
- (B) Starting on a separate page, appropriate remarks and arguments. 37 C.F.R. § 1.111 and MPEP 714; and
- (C) Starting on a separate page, a marked-up version entitled: "Version with markings to show changes made."

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a),

099000A/MAC

C

- 2 -

Better et al.  
Appl. No. 09/610,838

and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 19-0036.

**Amendments****In the Claims**

Please cancel claims 2 and 3 without prejudice or disclaimer.

Please rewrite the claims as follows:

*C* 4. ~~6~~ The fusion protein of any one of claims 1, ~~4~~ and ~~5~~, wherein said targeting sequence is an antibody.

5 7. The fusion protein of any one of claims 1, ~~4~~ and ~~5~~, wherein said targeting sequence is an antigen-binding portion of an antibody.

*C* 13 15. The fusion protein of any one of claims 1, ~~4~~ and ~~5~~, wherein said targeting sequence is a hormone.

14 16. The fusion protein of any one of claims 1, ~~4~~ and ~~5~~, wherein said targeting sequence is an antibody.

244

*C*

- 3 -

Better *et al.*  
Appl. No. 09/610,838

<sup>15</sup>  
17. The fusion protein of any one of claims 1, <sup>2</sup>4 and <sup>2</sup>5, wherein said targeting

sequence is a growth factor.

*C 2*  
*cond.*

NOV 20 2001

245

C

- 4 -

Better *et al.*  
Appl. No. 09/610,838**Remarks****1. The status of the claims**

Claims 1 and 4-17 are pending in this application. Reconsideration and entry of the above amendments is respectfully requested.

**2. The amendments**

No new matter has been added by the amendments.

Claim 2 has been canceled in view of claim 2 of U.S. 5,744,580, the scope of which is believed to be identical.

Claim 3 has been canceled in view of claim 3 of U.S. 5,744,580, the scope of which is believed to be identical.

The remaining amendments have been made to correct the claim dependencies in view of the cancellation of claims 2 and 3.

**a. The rejection under the judicially created doctrine of obviousness type double patenting over U.S. 5,837,491**

On Office Action page 5, claims 1-17 are rejected under the judicially created doctrine of obviousness type double patenting over claims 1-3 of U.S. 5,837,491 (herein "the '491 patent"). Applicants respectfully traverse this rejection.

Without acquiescing to the obviousness analysis in regard to the remaining part of the rejection, and as mentioned in Applicants' previous reply, solely in the interests of advancing

- 5 -

Better *et al.*  
Appl. No. 09/610,838

prosecution in this matter, submitted herewith is a terminal disclaimer. Accordingly, this rejection is believed moot.

***b. The rejection under the judicially created doctrine of obviousness type double patenting over U.S. 6,146,850***

On Office Action page 5, claims 1-17 are rejected under the judicially created doctrine of obviousness type double patenting over claims 1-3 of U.S. 6,146,850 (herein "the '850 patent"). Applicants respectfully traverse this rejection.

Without acquiescing to the obviousness analysis in regard to the remaining part of the rejection, and as mentioned in Applicants' previous reply, solely in the interests of advancing prosecution in this matter, submitted herewith is a terminal disclaimer. Accordingly, this rejection is believed moot.

***c. The rejection under the judicially created doctrine of obviousness type double patenting over U.S. 5,756,699***

On Office Action page 5, claims 1-17 are rejected under the judicially created doctrine of obviousness type double patenting over claims 1-3 of U.S. 5,756,699 (herein "the '699 patent"). Applicants respectfully traverse this rejection.

Without acquiescing to the obviousness analysis in regard to the remaining part of the rejection, and as mentioned in Applicants' previous reply, solely in the interests of advancing prosecution in this matter, submitted herewith is a terminal disclaimer. Accordingly, this rejection is believed moot.

C

- 6 -

Better *et al.*  
Appl. No. 09/610,838**d. U.S. Appln. No. 09/711,485**

Applicants' co-pending application no. 09/711,485 is also directed to fusion proteins. Without acquiescing to any obviousness analysis and solely in the interests of advancing prosecution in this matter, Applicants submit herewith a terminal disclaimer.

**Conclusion**

In view of the discussion above it is believed that the present application is now in condition for immediate allowance. Early notice to this effect is earnestly solicited. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

**Certification of Facsimile Transmission**

I hereby certify that this paper is being facsimile transmitted  
to the Patent and Trademark Office on the date shown below.

Michele A. Cimbalà  
Michele A. Cimbalà, Registration No. 33, 851

Date: 11/20/01

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN &amp; FOX P.L.L.C.

Michele A. Cimbalà  
Michele A. Cimbalà  
Attorney for Applicants  
Registration No. 33,851

Date: 11/20/01

1100 New York Avenue, Suite 600  
Washington, D.C. 20005-3934  
(202) 371-2600

- 7 -

Better *et al.*  
Appl. No. 09/610,838Version with markings to show changes made.

Please cancel claims 2 and 3 without prejudice or disclaimer.

Please amend the claims as follows:

6. The fusion protein of any one of claims 1, 4 and 5, [claim 1-5] wherein said targeting sequence is an antibody.

7. The fusion protein of any one of claims 1, 4 and 5, [1-5] wherein said targeting sequence is an antigen-binding portion of an antibody.

15. The fusion protein of any one of claims 1, 4 and 5, [1-5] wherein said targeting sequence is a hormone.

16. The fusion protein of any one of claims 1, 4 and 5, [1-5] wherein said targeting sequence is an antibody.

17. The fusion protein of any one of claims 1, 4 and 5, [1-5] wherein said targeting sequence is a growth factor.

C

**STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.**

ATTORNEYS AT LAW

1100 New York Avenue, N.W.

Suite 600

Washington, D.C. 20005-3934

**Facsimile Cover Sheet**

urgent ☐ return reply requested ☐ original will be sent as confirmation ☐

**DATE:** November 20, 2001**PHONE NO.:** 703 305 7401**PAGES:** 15 (including this cover sheet)**TO:** USPTO**ATTN:** Examiner A. Salimi**FROM:** Michele A. Cimbala**RE:** U.S. Utility Patent Application

Appl. No. 09/610,838; Filed: July 6, 2000

For: **Fusion Proteins And Polynucleotides Encoding Gelonin Sequences**Inventors: Better *et al.***OUR REF:** 0610.099000A/MAC**MESSAGE**

Transmitted herewith for appropriate action are the following documents:

1. SKGF Cover Letter;
2. Supplemental Amendment and Reply Under 37 C.F.R. § 1.111;
3. Certificate Under 37 C.F.R § 3.73(b)(2 pages); and
4. Four (4) Terminal Disclaimers.

**Certification of Facsimile Transmission**

I hereby certify that this paper is being facsimile transmitted  
to the Patent and Trademark Office on the date shown below.

**Michele A. Cimbala, Registration No. 33, 851****Date:**

11/20/01

This message is intended for the exclusive use of the individual or entity to which it is addressed. The message may contain information that is privileged, confidential, or otherwise exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution, copying or use of this communication in any way is strictly prohibited. If you have received this communication in error, please call us collect immediately, and return the original message to us at the above address via the U.S. Postal Service.

If any portion of this transmission is not received clearly or in full, contact us at any of the following numbers:

TELEPHONE NUMBER  
(202) 371-2600

FACSIMILE NUMBER  
(202) 371-2540



STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

ATTORNEYS AT LAW

1100 NEW YORK AVENUE, N.W. • WASHINGTON, D.C. 20005-3934

PHONE: (202) 371-2600 • FACSIMILE: (202) 371-2540 • [www.skqf.com](http://www.skqf.com)

ROBERT GREENE STERNE  
EDWARD J. KESSLER  
JORGE A. GOLDSTEIN  
SAMUEL L. FOX\*\*\*  
DAVID K.S. CORNWELL  
ROBERT W. ESMOND  
TRACY-GENE G. DURKIN  
MICHELE A. CIMBALA  
MICHAEL B. RAY  
ROBERT E. SOKOHL  
ERIC K. STEFFE  
MICHAEL Q. LEE  
STEVEN R. LUDWIG

JOHN M. COVERT  
LINDA E. ALCORN  
ROBERT C. MILLONIG  
MICHAEL V. MESSINGER  
JUDITH U. KIM  
TIMOTHY J. SHEA, JR.  
PATRICK E. GARRETT  
JEFFREY T. HELVEY\*  
HEIDI L. KRAUS  
JEFFREY R. KURIN  
PATRICK D. O'BRIEN  
LAWRENCE B. BUGAISKY  
CRYSTAL D. SAYLES

EDWARD W. YEE  
ALBERT L. FERRO\*  
DONALD R. BANOWIT  
PETER A. JACKMAN  
MOLLY A. MCCALL  
TERESA U. MEDLER  
JEFFREY S. WEAVER  
KENDRICK P. PATTERSON  
DONALD J. FEATHERSTONE  
VINCENT L. CAPUANO  
JOHN A. HARROUN\*  
ALBERT J. FASULO II\*  
ELDORA ELLISON FLOYD\*

W RUSSELL SWINDELL  
THOMAS C FIALA  
BRIAN J DEL BUONO  
VIRGIL L BEASTON\*  
RYAN J STAMPER\*  
REGINALD D LUCAS\*  
THEODORE A WOOD  
ELIZABETH J HAANES  
BRUCE E CHALKER  
JOSEPH S OSTROFF  
KAREN R MARKOWICZ\*\*  
SUZANNE E ZISKA\*  
ANDREA J KAMAGE\*\*

NANCY J. LEITH\*\*  
JOSEPH M. CONRAD, III\*\*  
DOUGLAS M WILSON\*\*  
ANN E SUMMERFIELD\*\*  
CYNTHIA M BOUCHEZ\*\*  
HELENE C CARLSON\*\*  
GABY L LONGSWORTH\*\*  
DUSTIN T JOHNSON\*\*  
MATTHEW J DOWD\*\*  
AARON L SCHWARTZ\*\*

\*LIMITED TO MATTERS  
AND PROCEEDINGS BEFORE  
FEDERAL COURTS & AGENCIES  
\*\*REGISTERED PATENT AGENT  
\*\*\*SENIOR COUNSEL

November 20, 2001

**WRITER'S DIRECT NUMBER:**  
(202) 371-2544

**INTERNET ADDRESS:**  
MCIMBALA@SKGF.COM

Commissioner for Patents  
Washington, D.C. 20231

***Via Facsimile to Examiner A. Salimi  
Art Unit 1643***

Re: U.S. Utility Patent Application  
 Appl. No. 09/610,838; Filed: July 6, 2000  
 For: **Fusion Proteins And Polynucleotides Encoding Gelonin Sequences**  
 Inventors: Better *et al.*  
 Our Ref: 0610.099000A/MAC

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Supplemental Amendment and Reply Under 37 C.F.R. § 1.111;  
2. Certificate Under 37 C.F.R. § 3.73(b)(2 pages); and  
3. Four (4) Terminal Disclaimers.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge the fee for Terminal Disclaimer and any other fee necessary, or credit any overpayment, to our Deposit Account No. 19-0036.

### Certification of Facsimile Transmission

I hereby certify that this paper is being facsimile transmitted  
to the Patent and Trademark Office on the date shown below.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Michèle A. Cimballa, Registration No. 33, 851

Date:

MAC:krm  
Enclosures

P:\USERS\KMURRAY\attys\MAC\0610\099-A\supp amend pto sht

**Michele A. Cimbala**  
Attorney for Applicant  
Registration No. 33,851